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TO: Examiner Jan M. Ludlow
Group Art Unit 1743

FIRM: U.S. Patent and Trademark Office

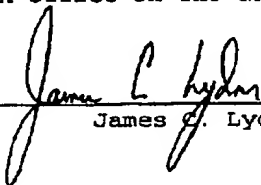
FACSIMILE NO.: 1-571-273-8300

FROM: James C. Lydon

RE: Request for Reconsideration
U.S. Patent Appl. S.N. 09/936,077
By: Bruno COLIN et al.
Atty. Case No.: BONN-060TOTAL PAGES: 7 including cover sheet.

DATE: March 23, 2006

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Bruno COLIN et al.

Serial Number: 09/936,077

Group Art Unit: 1743

Filing Date: December 3, 2001

Examiner: Ludlow, Jan M.

For: APPARATUS ENABLING LIQUID TRANSFER BY CAPILLARY ACTION THEREIN

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

March 23, 2006

Sir:

In response to the Official Action mailed December 23, 2005, please reconsider this application in view of the following remarks. Claims 9 and 13-16 are pending.

The 35 U.S.C. § 103(a) rejection of claims 9 and 13-16 over U.S. Patent No. 4,314,605 to Sumitomo et al. in view of U.S. Patent No. 5,413,872 to Faigle is respectfully traversed. The claimed apparatus includes at least one planar surface wherein at least two compartments are made and defined by a partition, the compartments creating a space which makes it possible to displace at least two liquid samples independently of one another. A feature of the claimed apparatus is that the compartments comprise at least two different types of grooves: at least one deep groove capable of

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partitioning samples from one another, the depth and width of the deep groove in relation to the partition being such that capillary action of a sample is not enabled, and at least two shallow grooves, each of the shallow grooves being capable of receiving one of the samples, respectively, the depth of the shallow grooves in relation to the partition being such that capillary action of the sample is enabled. A second feature of the claimed apparatus is that each shallow groove is adjacent to the deep groove along the entire length of the deep groove.

The cited combination of references is improper because both are non-analogous art, which make them unavailable for use against the claimed apparatus. More particularly, each reference fails both criteria for determining whether prior art is analogous: (1) whether the art is within the inventor's field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference is still reasonably pertinent to the particular problem with which the inventor is involved. See *In re Clay*, 966 F.2d 656, 23 U.S.P.Q.2d 1058 (Fed. Cir. 1992).

The present inventor's field of endeavor is fluid micromanipulation applications, which include apparatus for

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transferring liquids for the purpose of diagnostic testing (Specification, page 1, lines 9-13). In contrast, Sumitomo et al. lies in the field of heat exchanger condensers (Col. 1, lines 6-11), while Faigle lies in the field of filling or packing members where media are in direct contact for energy and/or mass exchange, or for chemical or biological reactions, or for mixing and separation processes (Col. 1, lines 6-13). Neither reference is in the field of fluid micromanipulation.

Both Sumitomo et al. and Faigle also fail Clay's second prong: neither reference is reasonably pertinent to the particular problem with which the present inventor is involved. More specifically, the claimed apparatus is directed to the problem of strong retention force in a fluid micromanipulation apparatus which employs capillary action to move liquid samples (Specification, page 2, lines 2-5, lines 7-10 and lines 17-22). In contrast, Sumitomo et al. seeks to improve the heat transmitting performance of surfaces on which steam condenses (Col. 1, lines 11-37). Faigle seeks to overcome the problem of reduced flow resistance and inefficient gas or energy exchange (Col. 2, lines 7-11 and Col. 1, 66 to Col. 2, line 6) in filling apparatus for cooling towers, chemical towers, drippers for waste water clarification, etc. (Col. 1, lines 15-28). Neither reference is directed to reducing strong

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retention forces in a fluid micromanipulation apparatus. Accordingly, neither reference is analogous art which may be cited against this application, *Clay, supra*.

The improper citation of Sumitomo et al. and Faigle fails to raise a *prima facie* case of obviousness against the claimed apparatus. A feature of the claimed apparatus is that its compartments create a space which makes it possible to displace at least two liquid samples independently of one another. Thus, there must be no communication between the deep and shallow grooves of the claimed apparatus. See Specification, page 7, lines 18-22 ("In practice, to ensure that liquids (5) and (15) remain in position in the shallow grooves (16) without mixing, the distance separating the bottom of the groove (16) and the partitioning film (4) should be small enough for capillary action to take place")(emphasis added).

Sumitomo et al. fails to disclose or suggest the non-mixing feature of the claimed apparatus. Instead, Sumitomo et al. disclose a condenser in which condensate is produced in steam passageways and is collected in longitudinal groove ridges 2b adjacent to the steam passageways. Sumitomo et al.'s steam and steam condensate are in intimate contact, because the condensate is initially collected in the steam passageways, and there is no

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separation between the steam passageways and the longitudinal groove ridges 2b.

Faigle also fails to disclose or suggest the non-mixing feature of the claimed apparatus, because its filling member includes slits between adjacent ducts to ensure direct contact between its "media". See Abstract, Col. 2, lines 27-28 and Col. 6, lines 33-38.

In short, the cited references are non-analogous art which have improperly been cited against the claimed apparatus. The improper combination of these references fails to disclose or suggest the claimed apparatus, which makes it possible to displace at least two liquids independently of one another. Reconsideration and withdrawal of the obviousness rejection of claims 9 and 13-16 are earnestly requested.

It is believed this application is in condition for allowance. Reconsideration and withdrawal of the sole rejection against claims 9 and 13-16, and issuance of a Notice of Allowance directed to those claims, are earnestly requested. The Examiner is urged to telephone the undersigned should she believe any further action is required for allowance.

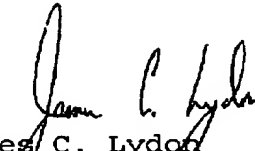
It is not believed any fee is required for entry and consideration of this Request. Nevertheless, the Commissioner is

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authorized to charge our Deposit Account No. 50-1258 in the amount
of any such required fee.

Respectfully submitted,



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